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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/458,415	12/10/1999	KEVIN GILLESPIE	06129-156001	8818
26161	7590	06/15/2004	EXAMINER	
FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 06/15/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/458,415

Applicant(s)

GILLESPIE

Examiner

Anthony D Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on April 8, 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 47-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 47-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 06 December 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The finality of the previous Office Action has been withdrawn and the application has been reopened for prosecution. An Office Action on the merits appears below.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: reference number 54', as shown in Figure 3, is not recited in the specification. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the

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art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat 6,092,251 in view of Official Notice. Tomat '251 discloses all the limitations substantially as claimed including the following: a shoe outsole with and outer member 4 with an inner heel region 9; an inner member 11 located in the inner heel region and including a ground contacting member (see col. 2, lines 50-52); the durometer, i.e. hardness, of the inner member is softer than that of the outer member (outer member is made of rubber while the inner member is made of lightweight polyurethane, EVA or TPU, all known for cushionability and impact resistance); intermediate member (11 in the forward are of the shoe) located in the intermediate region and made of the same material as the inner member so it is softer than the outer member as well; intermediate member is within 1.5 mm of a front edge of the outsole (see Figures 5-7); intermediate member can extend to within about 2 mm of a back edge since the heel member 11 and intermediate member 11 can be a single component (see col. 2, lines 50-52). Although Tomat '251 does not specifically state that the sole is made in different sizes, Official Notice is taken that shoes, as well as the shoe soles, have been made of different sizes to fit people

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with different sized feet. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the sole and shoe of Tomat '251 to fit any sized foot so as to allow people of different sized feet, even feet of babies, to use the shoe for it's intend purpose.

5. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 1 above in view of Patterson et al. 6,176,025. The reference as applied to claim 1 above discloses all the limitations of the claims except for the inner member containing liquid or air. Patterson et al. '025 teaches that a cushion used in cushioning the heel of a user's foot while in a shoe can be made of a bladder-like material that contains air, gel or any fluid to aid in distributing the impact forces of the user's foot with the ground. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the inner member of the reference as applied to claim 1 above out of a bladder containing air, liquid or gel, as taught by Patterson et al. '025, to aid in cushioning the impact of the user's foot with the ground and to better distribute the impact over the user's foot during the gait cycle.

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6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the reference as applied to claim 1 above in view of Lennihan, Jr. 5,875,568. The reference as applied to claim 1 above discloses all the limitations of the claim except for the outer member having a back wall that has a rounded contour extending smoothly between a horizontal plane and a vertical plane. Lennihan, Jr. '568 teaches that the back heel area of an athletic shoe with an insert can have a rounded heel that smoothly transitions from a horizontal plane to a vertical plane (see Figures 1 and 4) to transfer the energy of the user from the heel to the toe during the gait cycle at toe-off (see col. 2, lines 34-42). This transfer of energy aids in enhancing power during push-off during the stride. Therefore, it would have been obvious to make the back wall of the outer member if the reference as applied to claim 1 above rounded, so that it smoothly transitions between a horizontal plane and a vertical plane, as taught by Lennihan, Jr. '568, to aid in transferring the energy from the heel to the toe of the foot to help in toe-off, as taught by Lennihan, Jr.

7. Claims 47, 49-59, 61-65 and 67-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat 6,092,251 in view of Official Notice and Turner Des 417, 946. Tomat '251 discloses all the limitations substantially as claimed including

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the following: a shoe outsole with an outer member 4 with an inner heel region 9; an inner member 11 located in the inner heel region and including a ground contacting member (see col. 2, lines 50-52); the durometer, i.e. the hardness, of the inner member is softer than that of the outer member (outer member is made of rubber while the inner member is made of lightweight polyurethane, EVA or TPU, all known for cushionability and impact resistance.); inner member is within about 2 mm of the back edge of the outer member (see Figures 5-7); intermediate member (11 in the forward area of the shoe) located in the intermediate region and made of the same material as the inner member so it is softer than the outer member as well; intermediate member is within 1.5 mm of a front edge of the outsole (see Figures 5-7); intermediate member can extend to within about 2 mm of a back edge since the heel member 11 and intermediate member 11 can be a single component (see col. 2, lines 50-52). Tomat '251 does not teach the use of grooves and ridges. Although Tomat '251 does not specifically state that the sole is made in different sizes, Official Notice is taken that shoes, as well as the shoe soles, have been made of different sizes to fit people with different sized feet. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the sole

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and shoe of Tomat '251 to fit any sized foot so as to allow people of different sized feet, even feet of babies, to use the shoe for it's intend purpose. Turner '946 shows that grooves and ridges (seen in the Figures) can be located on the outer ground contacting surface of the sole. These grooves and ridges are shown as being located in the forefoot and heel regions of the sole and being substantially parallel to one another while being transverse and perpendicular to the longitudinal axis of the sole. The grooves and ridges are also shown to be located on the upper portion of the outer sole (as seen in Figure 3, they ride up the side of the sole) and extended to the edges of the outer sole. Therefore, it would have been obvious to place grooves and ridges, such as that shown in Turner '946, on the ground contacting portions of the sole of Tomat '251, that are located on the inner member and the intermediate member, to allow for better flexibility of the sole and to allow for better grip of the sole with the ground that it contacts.

8. Claims 60, 66, 74 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat 6,092,251 in view of Official Notice and Turner Des. 417,946 as applied above further in view of Lennihan, Jr. 5,875,568. Tomat '251 in view of Official Notice and Turner '946 discloses substantially all the limitations of the claims as noted above except for the outer

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member having a back wall that has a rounded contour extending smoothly between a horizontal plane and a vertical plane.

Lennihan, Jr., '568 teaches that the back heel area of an athletic shoe with an insert can have a rounded heel that smoothly transitions from a horizontal plane to a vertical plane (see Figures 1 and 4) to transfer the energy of the user from the heel to the toe during the gait cycle at toe-off (see col. 2, lines 34-42). This transfer of energy aids in enhancing power during push-off during the stride. Therefore, it would have been obvious to make the back wall of the outer member of Tomat '251 in view of Official Notice and Turner '946 as applied above, rounded so that it smoothly transitions between a horizontal plane and a vertical plane, as taught by Lennihan, Jr. '568, to aid in transferring the energy from the heel to the toe of the foot to help in toe-off, as taught by Lennihan, Jr.

9. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat 6,0992,251 in view of Official Notice and Turner Des 417,946 and Lennihan, Jr. 5,875,568. Tomat '251 discloses the following: a shoe outsole with an outer member 4 and an inner heel region 9; an inner member 11 located in the inner heel region and including a ground contacting member (see col. 2, lines 50-52); the durometer, i.e. the hardness, of the inner member is softer than that of the outer member (outer

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member is made of rubber while the inner member is made of lightweight polyurethane, EVA or TPU, all known for cushionability and impact resistance.); inner member is within about 2 mm of the back edge of outer member (see Figures 5-7); intermediate member (11 in the forward area of the shoe) located in the intermediate region and made of the same material as inner member so it is softer than the outer member as well; intermediate member is within 1.5 mm of a front edge of the outsole (see Figures 5-7); intermediate member 11 can be a single component (see col. 2, lines 50-52). Tomat '251 does not teach the use of grooves and ridges or the smooth transition of the back wall of the outer member from a horizontal plane to a vertical plane. Although Tomat '251 does not specifically state that the sole is made in different sizes, Official Notice is taken that shoes, as well as the shoe soles, have been made of different sizes to fit people with different sized feet. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the sole and shoe of Tomat '251 to fit any sized foot so as to allow people of different sized feet, even feet of babies, to use the shoe for its intended purpose.

Turner '946 shows that grooves and ridges (seen in Figures) can be located on the outer ground contacting surface of the

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sole. These grooves and ridges are shown as being located in the forefoot and heel regions of the sole and being substantially parallel to one another while being transverse and perpendicular to the longitudinal axis of the sole. The grooves and ridges are also shown to be located on the upper portion of the outer sole (as seen in Figure 3, they ride up the side of the sole) and extend to the edges of the outer sole. Therefore, it would have been obvious to place grooves and ridges, such as that shown in Turner '946, on the ground contacting portions of the sole of Tomat '251, that are located on the inner member and the intermediate member, to allow for better flexibility of the sole and to allow for better grip of the sole with the ground that it contacts.

Lennihan, Jr. '568 teaches that the back heel area of an athletic shoe with an insert can have a rounded heel that smoothly transitions from a horizontal plane to a vertical plane (see Figures 1 and 4) to transfer the energy of the user from the heel to the toe during the gait cycle at toe-off (see col. 2, lines 34-42). This transfer of energy aids in enhancing power during push-off during the stride. Therefore, it would have been obvious to make a back wall of the outer member of Tomat '251 in view of Official Notice and Turner '946, as applied above, rounded so that it smoothly transitions between a

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horizontal plans and a vertical plane, as taught by Lennihan, Jr. '568, to aid in transferring the energy from the heel to the toe of the foot to help in toe-off, as taught by Lennihan, Jr.

10. Claim 76 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat 6,092,251 in view of Official Notice as applied to claim 1 above. Tomat '251 in View of Official Notice, as applied to claim 1 above, discloses all the limitations of the claim except for the inner member being a softer durometer than the intermediate member. It is well-known in the art of foot cushions that the area of greatest impact, i.e. the heel area, should be made of a softer material than the other cushioning areas since it takes the brunt of the impact of the user's foot. This would allow for the appropriate cushioning of the heel without impacting the other areas of the user's foot. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the heel member of Tomat '251 softer than the intermediate member to allow for better cushioning of the heel without detracting from support of the arch and metatarsal areas of the foot.

Response to Arguments

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11. Applicant's arguments that the references do not teach or suggest a baby shoe or an outsole for a baby shoe are not clearly understood. Shoes and shoe soles are typically made of different lengths, widths or sizes so as to allow for use by people with different sized feet. Therefore, it would have been obvious to one of ordinary skill in the art to make the sole of Tomat in the sizes necessary to fit a multitude of different sized feet. Since all other structural limitations of the claims are met by Tomat, and the shoe and sole of Tomat can be sized to fit a baby's foot, Tomat would meet the limitations of the claimed invention. With respect to the Declaration of David Thorpe, this declaration is not sufficient to overcome all the claimed structure being met by Tomat and the ability of Tomat to be sized to fit any sized foot. Therefore, since the shoe of Tomat can be dimensioned to fit a baby's foot and Tomat includes all the other structural limitations of the claim, Tomat "reads on" the claimed invention. Appellant's other arguments were addressed in the Examiner's answer and would apply here as well. Applicant challenges the reasons set forth by the examiner supporting obviousness rejection of the independent claims. As shown in *In re Rose*, a change in the size of the sole or shoe is generally not given patentable weight or would have been obvious because shoes have been made in different sizes for different

sized feet, including those of a baby, to maximize the sales of the shoe and to allow people with different sized feet to benefit from the shoe.

Conclusion

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email CustomerService3700@uspto.gov.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday 8:00 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	http://www.uspto.gov/



Anthony D Stashick
Primary Examiner
Art Unit 3728

ADS

June 14, 2004